



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Philippe Gambier § Art Unit: 3677
Serial No.: 10/675,559 §
Filed: September 30, 2003 § Examiner: William L. Miller
For: Thermoplastic Seal and Method § Atty. Dkt. No.: SHL.0272US (68.0412)

Mail Stop AF

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Dear Sir:

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a Notice of Appeal.

Each of the independent claims was rejected as being obvious over "Admitted Prior Art" (APA) in view of Taylor. It is respectfully submitted that a *prima facie* case of obviousness has not been established with respect to the claimed subject matter for at least the reason that no motivation or suggestion existed to combine the reference teachings. *See* M.P.E.P. § 2143 (8th ed, Rev. 3), at 2100-135.

In response to Applicant's Reply to the final rejection, the Examiner provided additional arguments in the Advisory Action of June 6, 2006. Although the Office Action cited *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988) as purportedly supporting the obviousness rejection, it is respectfully submitted that the additional arguments made in the Advisory Action clearly indicate that the Examiner has used impermissible hindsight to make the obviousness rejection, which is specifically what *In re Fine* specifically prohibits. Essentially, the argument made in the Advisory Action is as follows: (1) Taylor teaches element 1; and (2) APA teaches

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<u>Ginger Yount</u>	
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element 2 – therefore, Taylor and APA can be combined to achieve the claimed invention. Without the present invention as a template, a person of ordinary skill in the art clearly would not have been motivated to combine APA and Taylor in the manner proposed by the Office Action. As *In re Fine* warns, “[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.” *In re Fine*, 837 F.2d at 1075.

The Advisory Action further improperly referred to “knowledge generally available to one of ordinary skill in the art.” Advisory Action at 2. The Advisory Action does not state what this “knowledge” includes, nor does the Advisory Action cite to any evidence to support such “knowledge.” In fact, the final Office Action dated March 28, 2006 never cited to such “knowledge generally available to one of ordinary skill.” Without explaining what the “knowledge” specifically includes, and without citing to objective evidence to establish this “knowledge,” the Examiner has clearly erred in relying on this “knowledge” to provide the motivation to combine APA and Taylor.

The final Office Action referred to the “Related Art” section of the present application as being the APA. The “Related Art” section provides a description regarding failure of a seal in control line connections. The “Related Art” section further discusses that a prior art downhole seal can include a rubber or elastomeric seal, a metal-to-metal seal, and a seal that depends upon fluidic pressure. The remaining portion of the “Related Art” section of the present application indicates that these prior art seals are often unreliable or not suitable for certain applications. Importantly, there is absolutely no suggestion whatsoever in the “Related Art” section of a preload member to apply a force to and induce cold flow of a thermoplastic seal to seal against the outer surface of a cable, as recited in the claims.

Recognizing that the APA fails to disclose or even remotely suggest this claim feature, the Office Action instead relied upon Taylor. 3/28/2006 Office Action at 2. Reference was made by the Office Action to a thermoplastic seal 19 and metal ferrules 11, 12 that abut ends of the seal 19 in Taylor. However, aside from picking and choosing isolated disclosures in the cited references, the Office Action has failed to cite any objective evidence of the required motivation or suggestion to combine the teachings of APA and Taylor.

Although Taylor teaches sealing at a coupling 6 between two pipes 1 and 2 (see Figs. 1 and 2 of Taylor), there is no suggestion in Taylor of using its mechanism to seal against an outer

surface of a cable. Similarly, the APA fails to provide any suggestion of a preload member to apply a force to and induce cold flow of a thermoplastic seal.

Clearly, neither Taylor nor APA even remotely suggests a preload member to apply a force to and *induce cold flow of a thermoplastic seal to seal against the outer surface of the cable*, as recited in claim 1. Because the Office Action has failed to cite to any motivation or suggestion to combine the teachings of APA and Taylor, a *prima facie* case of obviousness has clearly not been established with respect to independent claim 1.

With respect to independent claim 15, APA and Taylor do not teach or suggest inducing cold flow deformation of a component formed of a thermoplastic to create a fluidic seal against the outer surface of a control line.

With respect to independent claim 28, APA and Taylor do not teach or suggest a seal member deformed by cold flow about at least a portion of a ferrule to seal against the outer surface of a control line.

With respect to independent claim 38, APA and Taylor do not teach or suggest a deformed thermoplastic seal member that provides a fluidic seal against a housing and a cable.

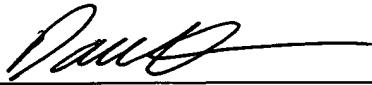
Dependent claims are allowable for at least the same reasons as corresponding independent claims. In view of the allowability of the independent claims over APA and Taylor, it is respectfully submitted that the § 103 rejections over APA, Taylor, and Evans, and over APA, Taylor, and Wadahara have also been overcome.

Additional arguments were raised by Applicant against obviousness rejections of certain dependent claims in the Reply to Office Action, which arguments are incorporated by reference herein.

Withdrawal of the final rejections is therefore respectfully requested. The Commissioner is authorized to charge any additional fees and/or credit any overpayment to Deposit Account No. 20-1504 (SHL.0272US).

Respectfully submitted,

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